

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

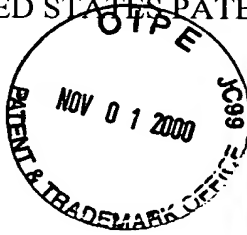
In re application of:

Rothschild *et al.*

Appl. No. 09/407,371

Filed: September 28, 1999

For: **Server-Group Messaging System
for Interactive Applications**



Art Unit: 2758

Examiner: *To Be Assigned*

Atty. Docket: 1719.0050002

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EXR. note put 2 (Box)
for References

**FIRST SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT
UNDER MPEP § 2001.06(C)**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO-1449 are ninety-seven (97) documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The documents listed on the accompanying Form PTO-1449 were brought to the attention of the undersigned due to a litigation captioned HearMe v. Lipstream Networks, Inc., Case No. C-99-04506 (WHA), filed in the United States District Court for the Northern District of California on October 8, 1999. This suit involved U.S. Patents Nos. 5,822,523 and 6,018,766, to which the present application claims priority under 35 U.S.C. § 120. The suit was ultimately settled on August 30, 2000.

The defendants in the suit alleged invalidity and unenforceability of both U.S. Patent Nos. 5,822,523 and 6,018,766 based on the ninety-four (94) documents listed on the accompanying Form PTO-1449. These ninety-four documents were cited by the defendant in three "Response Charts" (Documents AN13, AO13 and AP13 listed on the accompanying Form PTO-1449) which are required by Local Rules 16-7 and 16-9 of the United States District Court for the

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- 2 -

NOV 02 2000

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Technology Center 2100

Northern District of California. Thus, due to the requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98, as well as MPEP § 2001.06(c) (7th ed., Rev. 1, Feb. 2000), the undersigned felt it best to cite all ninety-four documents, and the three Response Charts themselves, on the accompanying Form PTO-1449.

Applicants note that three documents listed in one of the defendant's Response Charts are drafts of the same Request for Comment (RFC) document and are no longer available from the Internet Engineering Task Force (IETF). The three documents are:

Schulzrinne *et al.*, "RTP: A Transport Protocol for Real-Time Applications," *IETF Internet Draft draft-ietf-avt-rtp-03.txt*, December 1992;

Schulzrinne *et al.*, "RTP: A Transport Protocol for Real-Time Applications," *IETF Internet Draft draft-ietf-avt-rtp-07.txt*, December 1992; and

Schulzrinne *et al.*, "RTP: A Transport Protocol for Real-Time Applications," *IETF Internet Draft draft-ietf-avt-rtp-05.txt*, 1994.

They are unavailable because, according to IETF policy, older drafts of RFCs must be updated within six months or are deleted from their archives. See www.ietf.org/ID.html (IETF's "Internet Drafts" link), visited by the undersigned on September 5, 2000. Document AQ12 listed on the accompanying Form PTO-1449, dated July 14, 2000, however, is the most recent draft of these IETF RFCs that are no longer available.

Further, of the ninety-four documents cited in the three Response Charts, it is the undersigned's understanding that Documents AQ6, AM7-AP7, AP12 and AQ12 listed on the accompanying Form PTO-1449--all drafts of the same IETF RFC document--were the documents primarily relied upon by the defendants for their assertion of invalidity and unenforceability during the suit. See *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1182-83 (Fed. Cir. 1995) (discussion of inequitable conduct and "burying" references).

Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to further establish the patentability of the claimed invention over any of the listed documents should they be applied as references, and/or to prove that some of these documents may not be prior art, and/or to prove that some of these documents may not be enabling for the teachings they purport to offer.

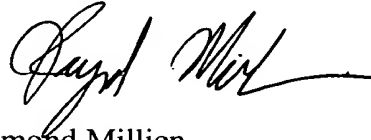
This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that was cited or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required. Nevertheless, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this pleading is enclosed.

Respectfully submitted,

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Date: 11/1/00

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